Paper No. 35

# UNITED STATES PATENT AND TRADEMARK OFFICE

---

# BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

---

Ex parte SUN-YI HUANG, LOUIS ROSATI,
and JOSEPH J. KOZAKIEWICZ

---

Appeal No. 2001-0061
Application No. 08/720,851

---

ON BRIEF

---

Before GARRIS, TIMM, and MOORE, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

## DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 1-22, which are all of the claims in the application.

The subject matter on appeal relates to an aqueous dispersion composition comprising (a) a first cationic water-soluble or water-swellable polymer, (b) a second water-soluble polymer different from the first, (c) a kosmotropic salt and (d) a chaotropic salt, wherein the amounts of (b), (c) and (d) are such that a homogeneous composition

is obtained in the absence of (b). Further details of this appealed subject matter are set forth in representative independent claim 1, which reads as follows:

1. A composition comprising an aqueous dispersion comprised of:
(a) a first cationic water-soluble or water-swellable polymer; and
(b) at least one second water-soluble polymer different from said first polymer; and
(c) a kosmotropic salt; and
(d) a chaotropic salt,
wherein the amounts of said (b), (c) and (d) are such that a homogeneous composition is obtained in the absence of said (b), and wherein the amounts of said (c) and (d) are effective to reduce the bulk viscosity of said aqueous dispersion.

The reference relied upon by the examiner as evidence of obviousness is:

| | | |
|---|---|---|
| Ramesh et al. (Ramesh) | 5,597,858 | Jan. 28, 1997 (filed Mar. 22, 1995) |

The references relied upon by the appellants as evidence of non-obviousness are:

| | | |
|---|---|---|
| Takeda et al. (Takeda '590) | 5,006,590 | Apr. 9, 1991 |
| Takeda et al. (Takeda '655) | 4,929,655 | May 29, 1990 |

All of the appealed claims stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ramesh.

We refer to the Brief and Reply Brief and to the Answer for a complete exposition of the opposing viewpoints expressed by the appellants and by the examiner concerning the above noted rejection.

OPINION

This rejection cannot be sustained.

The pivotal issue on this appeal relates to the claim limitation "wherein the amounts of said (b), (c) and (d) are such that a homogeneous composition is obtained in the absence of said (b)" which is recited in each of the independent claims before us. According to the examiner, "[t]his limitation is presumed to be inherently possessed by the Examples [i.e. Examples 13 and 15 of Ramesh] or rendered prima facie obvious by these examples given that the amounts of the salts to be incorporated disclosed in the specification at pages 18 and 19 overlap those percentages as shown in the prior art." (Answer, page 4). We cannot agree.

The examiner's above quoted position relating to inherency is not without some rational basis. Nevertheless, we share the appellants' fundamental viewpoint that the examiner's unpatentability position is unconvincing. In particular, we believe (1) that the multivalent anionic salt of Ramesh performs the intended function of insolubilizing or depositing patentees' cationic polymer in his aqueous solution of the polyvalent anionic salt and (2) that such a function is antithetical to the unpatentability position of the examiner.

This belief is supported by substantial evidence in the record of this appeal including the Ramesh patent itself, the Takada '655 patent as well as various examples in the appellants' specification. However, the evidence which most clearly supports this belief constitutes the disclosure which appears on lines 42-43 in column 6 of Ramesh wherein patentee teaches that his "multivalent anionic salt [is] used to deposit the polymer in the present invention." This disclosure, particularly when considered in

conjunction with the disclosure of Takada '655 (which is incorporated by reference into the specification of Ramesh; see lines 30-32 in column 1 of Ramesh), reflects that Ramesh deliberately intends his multivalent anionic salt to insolubilize or deposit his polymer, thereby forming a heterogeneous composition. Viewed from this perspective, the disclosure of Ramesh is antithetical to obtaining a homogeneous composition in the absence of patentee's polymer dispersant (which the examiner equates to the here claimed second water-soluble polymer (b)).

Thus, when considered as a whole, the evidence before us clearly weighs in favor of a determination that the dispersion composition of Ramesh is not capable of, and indeed was not intended by patentee to be capable of, forming a homogeneous composition in the absence of his water-soluble dispersant (i.e., the here claimed polymer "(b)" according to the examiner). It follows that the "homogeneous composition" feature claimed by the appellants would not be inherently possessed by, and would not have been rendered obvious by, the dispersions disclosed in Examples 13 and 15 of Ramesh as urged by the examiner. We cannot sustain, therefore, the examiner's § 103 rejection of appealed claims 1-22 as being unpatentable over Ramesh.

The decision of the examiner is reversed.

**REVERSED**

| | |
|---|---|
| | ) |
| Bradley R. Garris | ) |
| Administrative Patent Judge | ) |
| | ) |
| | ) |
| | ) BOARD OF PATENT |
| Catherine Timm | ) |
| Administrative Patent Judge | ) APPEALS AND |
| | ) |
| | ) INTERFERENCES |
| | ) |
| James T. Moore | ) |
| Administrative Patent Judge | ) |

ELD

Knobbe, Martens, Olson & Bear, LLP
2040 Main Street
Fourteenth Floor
Irvine, CA 92614